REMARKS

Applicant requests reconsideration and allowance of the present application in view of the following remarks.

Claims 1-38 are pending in the present application. Claims 1, 9, and 16 are the independent claims.

Claims 1-22 and 24-38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,484,178 (Bence, Jr. et al.) in view of U.S. Patent No. 6,594,664 (Estrada et al.). Claim 23 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Bence et al. in view of Estrada et al. and further in view of JP 9282209 (Yuichi). All rejections are respectfully traversed.

Independent claim 1 recites, inter alia, a specifying control unit implementing a specifying module which performs two different operations, a first operation in which the specifying module firstly selects the data file and secondly drags the selected data file to the format file, and a second operation in which the specifying module firstly selects the format file and secondly drags the selected format file to the data file.

Independent claims 9 and 16 recite similar features in method and readable-by-computer medium forms, respectively.

By the aforementioned features, two different operations are performed in the specifying. Thus, operational efficiencies can be realized.

The rejections of the claims are traversed for at least the following three reasons:

1) The Office Action has failed to make out a prima facie case of obvious by failing to consider each feature of the claims as presented by the Amendment filed December 27, 2005;

2) The asserted combination of citations does not disclose the second of the aforementioned expressly recited features of independent claims 1, 9, and 16; and

3) The Office's interpretation of secondary citation to Estrada et al. is contradictory to the express teachings of Estrada et al.

Applicant acknowledges the Office's asserted definition of "drag-and-drop" at page 8 of the Office Action. However, the Office's application of this defined phrase, as manifested by the discussion in the "Response to Argument" section of the Office Action, evidences a failure to

8

consider each and every feature of the rejected claims. Specifically, the Office Action states:

> It is submitted that the act of "clicking" is equivalent with the claimed limitation "selecting" (i.e., first operation) and the drag-and-drop operation to move the object is the "second operation."

(Office Action, page 8). However, independent claims 1, 9, and 16 do not merely recite "'firstly selecting the data file' and 'secondly drags the selected data file...'". (Office Action, page 8). Instead, independent claim 1, for example, recites a specifying module which performs the following two different operations: (1) a first operation in which the specifying module firstly selects the data file and secondly drags the selected data file to the format file; and (2) a second operation in which the specifying module firstly selects the format file and secondly drags the selected format file to the data file. Thus, the characterization of the claims ignores the express recitations of claim 1, for example, "and a second operation in which the specifying module firstly selects the format file and secondly drags the selected format file to the data file. (Emphasis added). Indeed, it appears that the Office Action, as summarized by the Response to Argument section of the Office Action, is directed to the claims as presented before the Amendment filed December 27, 2005, not as presently presented for examination. Thus, the features of the claims as presently presented have not been addressed. And, consequently, a prima facie case of obviousness has not been made. For this reason alone, the rejections are traversed.

The rejections are traversed for another reason. As presently presented, independent claims 1, 9, and 16 now recite a feature which permits the following: (1) a format file can be selected and dragged to a data file; and (2) a data file can be selected and dragged to a format file. Applicants respectfully submit that such functionality is not rendered obvious by the mere definition of a "drag-and-drop" operation. Rather, in the case of independent claim 1, for example, the expressly recited features provide enhanced functionality by providing a user with two ways to deliver item data of a selected data file and the fixed format of a format file to the setting unit. And, by this feature, it is possible to input a plurality of data sets (each data file including at least one set) into a single format and to format a single set of data into a plurality of formats.

In contrast to present invention as recited in independent claims 1, 9, and 16, Estrada et al. discloses only "one-way" delivery of a selected file to a target. In detail, Estrada et al. discusses only selecting and dragging a non-HTML file to an area on a form so that the non-HTML file can be rendered in HTML format. (Estrada et al., Col. 21, lines 1-30). Absent from Estrada et al. is any disclosure of selecting and dragging a form to a non-html file. The absence of a disclosure in Estrada et al. of both (i) selecting a format file and dragging the selected

format file to a data file <u>and</u> (ii) selecting a data file and dragging the selected data file to a format file renders the asserted combination of <u>Bence Jr., et al.</u> and <u>Estrada et al.</u> deficient. Thus, the asserted combination does not render obvious the aforementioned features of independent claims 1, 9, and 16.

The rejections are traversed for still another reason. <u>Estrada et al.</u> expressly teaches that the above-described delivery of the non-HTML file to the form is significant because it permits the user to see the non-HTML file in its original format (to permit editing) while others viewing the page see the file in an HTML format. (<u>Estrada et al.</u>, Col. 21, lines 5-11). For this reason, <u>Estrada et al.</u> is silent as to delivery of the form to the non-HTML file. Further, this is silence is not surprising because <u>Estrada et al.</u>'s "one-way" delivery of a selected file is not reversible so that the form can be delivered to the non-HTML file. For at least this additional reason, it is respectfully submitted that <u>Estrada et al.</u> teaches away from dragging and dropping the form on the data file.

The tertiary citation to <u>Yuichi</u> relates to a file setting method and is cited by the Office Action for its teaching of displaying files as a list. (<u>Office Action</u>, page 7). However, Applicant respectfully submits that <u>Yuichi</u> adds nothing that would remedy the aforementioned deficiency in the teachings or suggestions of <u>Bence, Jr. et al.</u> and <u>Estrada et al.</u>

Accordingly, favorable reconsideration and withdrawal of the rejections under 35 U.S.C. § 103 are respectfully requested.

In view of the foregoing, Applicant respectfully submits that the independent claims patentably define the present invention over the citations of record. Further, the dependent claims should also be allowable for the same reasons as their respective base claims and further due to the additional features that they recite. Separate and individual consideration of the dependent claims is respectfully requested.

Applicant submits that this Request clearly places the subject application in condition for allowance. The remarks presented herein were not earlier presented because Applicants believed that the prior Amendment placed the subject application in condition for allowance. Accordingly, entry of the instant Request as an earnest attempt to advance prosecution and reduce the number of issues is requested under 37 C.F.R. § 1.116.

Applicant believes that the present Request is responsive to each of the points raised by the Examiner in the Official Action. However, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to such matters.
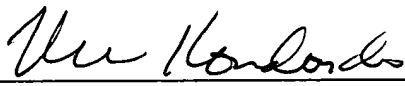
matters.

There being no further outstanding objections or rejections, it is submitted that the present application is in condition for allowance. An early action to that effect is courteously solicited.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 8-11-06

By: _____
Michael E. Kondoudis
Registration No. 42,758

1201 New York Avenue, NW, Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501